

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Keohane, et al.	§	Group Art Unit: 2452
	§	
	§	
Serial No.: 10/621,930	§	Examiner: HUSSAIN, TAUQIR
	§	
Filed: 7/17/2003	§	Attorney Docket No.: AUS920030357US1
	§	
For: SYSTEM AND METHOD FOR	§	Customer No. 32329
ALERTING ELECTRONIC MAIL	§	
USERS OF UNDELIVERABLE	§	
RECIPIENTS	§	

RENEWED PETITION UNDER 37 CFR 1.137(b)/RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

If any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. If an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

In response to the Decision on Petition dated February 2, 2010, please amend the above-identified application as follows:

Listing of Claims begins on page 2 of this paper.

Remarks begin on page 4 of this paper.

CLAIMS

This listing of the claims will replace all prior versions, and listings, of claims in the application:

Claims 1-2 (cancelled)

Claim 3 (previously presented) A method for alerting e-mail users comprising:

- if a failed delivery e-mail message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message;

- displaying said address in conjunction with a perceptive cue in response to said indicator being set;

- wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible; and

- clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Claims 4-9 (cancelled)

Claim 10 (previously presented) A computer program product embodied in a tangible storage medium, the program product for alerting e-mail users comprising programming instructions for:

- if a failed delivery e-mail message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message;

- displaying said address in conjunction with a perceptive cue in response to said indicator being set;

- wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible; and

programming instructions for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Claims 11 - 16 (cancelled)

Claim 17 (previously presented) A data processing system comprising:

circuitry operable for, if a failed delivery message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message;

circuitry operable for displaying said address in conjunction with a perceptive cue in response to said indicator being set;

wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible; and

circuitry operable for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Claims 18-20 (cancelled)

REMARKS

Claims 3, 10 and 17 are pending in the present application. Of these, Claims 3, 10 and 17 are independent. No Claims have been amended. Claims 1-2, 4-9 and 11-16 were previously cancelled. Reconsideration and allowance of the claims is respectfully requested.

In the Advisory Action associated with the dismissal of the petition to revive, the Examiner argued that the disqualification of the primary reference did not constitute a prima facie case of allowability as required in association with the Petition to Revive. While Applicants respectfully traverse the Examiner's argument on the basis that disqualifying the primary reference should place the claims in condition for allowance since no other reference was presented that applied to those elements of the claim, in order to expedite prosecution, Applicants have included an RCE to remove the finality of the Final Office Action and have the Examiner re-consider the claims. The previously filed Response is included. Thus, this Petition to Revive for Unintentional Abandonment should now be in condition for approval. Therefore, Applicants request reconsideration of the dismissal of this Petition to Revive.

CONCLUSION

Applicant respectfully submits that all claims now pending are in condition for allowance and respectfully requests such allowance.

The 2-month shortened statutory period for Response to the current Decision on Petition expires on April 2, 2010. It is believed that no other fees are due with the filing of this Response. However, should any additional fees be due, or any overpayments to be repaid, the Commissioner is hereby authorized to charge or repay such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

DATE: 4/2/2010

/Matthew B. Talpis/

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MAILED

FEB 02 2010

OFFICE OF PETITIONS

In re Application of :
Susann Marie Keohane et al. :
Application No. 10/621,930 : ON PETITION
Filed: July 17, 2003 :
Attorney Docket No. AUS920030357US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 10, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed November 10, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 11, 2009.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.29(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1).

The proposed reply required for consideration of a petition to revive must be either a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted on May 28, 2009, does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). A copy of the Advisory Action explaining why the amendment was not accepted is enclosed with this decision.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

A handwritten signature in black ink, appearing to read 'JoAnne Burke', is written over a faint, circular official stamp.

JoAnne Burke
Petitions Examiner
Office of Petitions

Enclosed: Copy of Advisory Action

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/921,930

Applicant(s)

KEOHANE ET AL.

Examiner

TAUQIR HUSSAIN

Art Unit

2452

-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED 10 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(b).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.119 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 3, 10 and 17.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.39(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached information Disclosure Statement(s). (PTO/SB08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11, does NOT place the application in condition for allowance because: Current amendments filed on 11/10/2009 will not put the application in condition for allowance. At best Examiner will issue a supplementary office action to overcome the amendments and arguments.